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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,938	08/22/2003	Takaharu Nakamura	FUSA 20.586	1772
26304	7590	06/02/2005	EXAMINER	
KATTEN MUCHIN ROSENMAN LLP			FOX, BRYAN J	
575 MADISON AVENUE			ART UNIT	
NEW YORK, NY 10022-2585			PAPER NUMBER	
			2686	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/646,938

Applicant(s)

NAKAMURA, TAKAHARU

Examiner

Bryan J Fox

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) ✓
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/22/03. ✓
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Dent et al (US005282250A).

Regarding **claim 1**, Dent et al disclose bi-directional authentication between a mobile station and a base station, so that it is not only the base station that requires the identity of the mobile station, but the mobile station that requires the identity of the base station (see column 1, line 67 – column 2, line 7), which reads on the claimed, “mobile terminal in a mobile communication system for authenticating a communicating party when communication is performed between the mobile terminal and a device on the side of a network.” After the base station authenticates the mobile station, the base station forms a response signal from a further random number RAND2 and from the personal identification number PIN of the mobile, this number being known in the base station and this is sent to the mobile station. The mobile station forms a value of RESP2 from its PIN and the received number RAND2 and compares this formed value with the received RESP2. If the two values coincide, the method proceeds (see column 3, lines 4-34 and figure 2), which reads on the claimed, “authentication processing means which, when a request signal requesting operation execution is received from a

network device, is for executing authentication processing to check whether said request signal is a request signal from an authorized network device; and operation execution means for executing an operation that is in accordance with said request signal only if authentication that the network device is an authorized network device is obtained."

Regarding **claim 5**, Dent et al disclose bi-directional authentication between a mobile station and a base station, so that it is not only the base station that requires the identity of the mobile station, but the mobile station that requires the identity of the base station (see column 1, line 67 – column 2, line 7), which reads on the claimed, "mobile communication system for authenticating a communicating party when communication is performed between a mobile terminal and a device on the side of a network." After the base station authenticates the mobile station, the base station forms a response signal from a further random number RAND2 and from the personal identification number PIN of the mobile, this number being known in the base station and this is sent to the mobile station. The mobile station forms a value of RESP2 from its PIN and the received number RAND2 and compares this formed value with the received RESP2. If the two values coincide, the method proceeds (see column 3, lines 4-34 and figure 2), which reads on the claimed, "authentication processing means which, when a signal requesting execution of a prescribed operation has been received from a network device, is for sending an authentication request signal to the network device in order to determine whether said request signal is a request signal from an authorized network device; performing an authentication operation; and comparing result of this

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authentication operation with result of an authentication operation sent from the network device; and operation execution means for executing an operation that is in accordance with said request signal only if authentication that the network device is an authorized network device is obtained; and said network device includes an authentication operation unit for executing an authentication operation based upon an authentication request signal received from said mobile terminal based upon an authentication request signal received from said mobile terminal, and sending result of this authentication operation to the mobile terminal.”

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2, 4, 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dent et al in view of Hayashi et al (US006321094B1).

Regarding **claim 2**, Dent et al disclose that after the base station authenticates the mobile station, the base station forms a response signal from a further random number RAND2 and form the personal identification number PIN of the mobile, this number being known in the base station and this is sent to the mobile station. The mobile station forms a value of RESP2 from its PIN and the received number RAND2 and compares this formed value with the received RESP2. If the two values coincide, the method proceeds and the mobile forms a value RESP3 from the PIN and RAND2 and sends this value to the base station (see column 3, lines 4-34 and figure 2), which reads on the claimed, "means for storing an identifier and key information of a mobile terminal...an authentication operation unit for executing a prescribed authentication operation using said key information and random number; an authentication request signal transmitter for creating an authentication request signal transmitter for creating an authentication request signal, which includes said terminal identifier and random number, and sending this signal to the network device; a receiver for receiving an authentication result, which has been obtained by an authentication operation performed on the network side, from the network device; and a comparator for comparing the authentication result computed by the mobile terminal and the authentication result sent form the network device; and said operation execution means executes the operation that is in accordance with said request signal upon deciding that the network device is an authorized network device when the compared results agree." Dent et al fail to expressly disclose that the mobile terminal includes a random number generator.

In a similar field of endeavor, Hayashi et al disclose a mobile terminal that includes a random number generator (see column 3, lines 7-21).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Dent et al with Hayashi et al to include the above random number generator in the mobile terminal in order to conserve the processing required to generate and send a random number at the system level.

Regarding **claim 4**, Dent et al disclose bi-directional authentication between a mobile station and a base station, so that it is not only the base station that requires the identity of the mobile station, but the mobile station that requires the identity of the base station (see column 1, line 67 – column 2, line 7), which reads on the claimed, “network device in a mobile communication system for authenticating a network device by comparing, at a mobile terminal, authentication results computed by respective ones of the mobile terminal and network device when communication is performed between these two devices.” After the base station authenticates the mobile station, the base station forms a response signal from a further random number RAND2 and from the personal identification number PIN of the mobile, this number being known in the base station and this is sent to the mobile station. The mobile station forms a value of RESP2 from its PIN and the received number RAND2 and compares this formed value with the received RESP2. If the two values coincide, the method proceeds (see column 3, lines 4-34 and figure 2), which reads on the claimed, “means for sending a signal, which requests that a mobile terminal execute a prescribed operation, to said mobile terminal... a receiver for receiving, from the mobile terminal that has received said

request signal, an authentication request signal that includes the identifier and random number of said mobile terminal,” and, “an authentication operation unit for executing an authentication operation,” and, “a transmitting unit for transmitting the authentication result to the mobile terminal.” Dent et al fails to disclose the use of a table for storing correspondence between an identifier and key information of a mobile terminal and a key-information acquisition unit for acquiring key information, which corresponds to the received identifier of the mobile terminal, from said table.

In a similar field of endeavor, Hayashi et al disclose the use of a database to store the necessary information for authentication (see column 3, lines 7-33).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Dent et al with Hayashi et al to include the above storage of authorization information in order to avoid using the processing resources to compute the data.

Regarding **claim 6**, Dent et al disclose that after the base station authenticates the mobile station, the base station forms a response signal from a further random number RAND2 and from the personal identification number PIN of the mobile, this number being known in the base station and this is sent to the mobile station. The mobile station forms a value of RESP2 from its PIN and the received number RAND2 and compares this formed value with the received RESP2. If the two values coincide, the method proceeds (see column 3, lines 4-34 and figure 2), which reads on the claimed invention with an authentication operation unit for executing a prescribed authentication operation using key information and random number, “an authentication

request signal transmitter for creating an authentication request signal, which includes said terminal identifier and random number, and sending this signal to the network device; a receiver for receiving result of an authentication operation obtained by an authentication operation of the network device; and a comparator for comparing result of the authentication operation performed by the mobile terminal and the result of the authentication operation sent from the network device; and the authentication processing means decides that the network device is an authorized device when the compared results agree." Dent et al fail to disclose that the mobile terminal includes a random-number generator for generating any random number.

In a similar field of endeavor, Hayashi et al disclose a mobile terminal that includes a random number generator (see column 3, lines 7-21 and figure 2).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Dent et al with Hayashi et al to include the above random number generator in the mobile unit in order to conserve the processing required to generate and send a random number at the system level.

Regarding **claim 8**, Dent et al disclose that after the base station authenticates the mobile station, the base station forms a response signal from a further random number RAND2 and from the personal identification number PIN of the mobile, this number being known in the base station and this is sent to the mobile station. The mobile station forms a value of RESP2 from its PIN and the received number RAND2 and compares this formed value with the received RESP2. If the two values coincide, the method proceeds (see column 3, lines 4-34 and figure 2), which reads on the

claimed, "means for sending a mobile terminal a request signal requesting execution of an operation... a receiver for receiving, from a mobile terminal that has received said request signal requesting execution of the operation, an authentication request signal that includes an identifier... of said mobile terminal," and, "an authentication operation unit executes an authentication operation," and, "sending result of the authentication operation to the mobile terminal." Dent et al fails to disclose the use of a table for storing correspondence between an identifier and key information of a mobile terminal and a key-information acquisition unit for acquiring key information, which corresponds to the received identifier of the mobile terminal, from said table or the random number being sent from the terminal.

In a similar field of endeavor, Hayashi et al disclose the use of a database to store the necessary information for authentication (see column 3, lines 7-33) and a random number generating unit at the mobile terminal.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Dent et al with Hayashi et al to include the above storage of authorization information and random number generating unit at the mobile in order to avoid using the processing resources to compute the data and generate and send random numbers at the network.

Claims 3, are rejected under 35 U.S.C. 103(a) as being unpatentable over Dent et al in view of Jiang et al (US 20020057678A1).

Regarding **claim 3**, Dent et al disclose bi-directional authentication between a mobile station and a base station, so that it is not only the base station that requires the identity of the mobile station, but the mobile station that requires the identity of the base station before a call is completed (see column 1, line 67 – column 2, line 7), which reads on the claimed, “said authentication processing means executes authentication processing if a request is one requiring authentication, and said operation execution means executes the operation that is in accordance with said request signal if authentication that the network device is an authorized network device is obtained.” Dent et al fail to expressly disclose forgoing authentication processing if a request is not one requiring authentication.

In a similar field of endeavor, Jiang et al disclose skipping authentication if it is not necessary for a particular application (see paragraph 208).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Dent et al with Jiang et al to include the above skipping authentication when not necessary for an application in order to conserve system resources.

Regarding **claim 7**, Dent et al disclose bi-directional authentication between a mobile station and a base station, so that it is not only the base station that requires the identity of the mobile station, but the mobile station that requires the identity of the base station before a call is completed (see column 1, line 67 – column 2, line 7), which reads on the claimed, “said authentication processing means executes authentication processing if a request is one requiring authentication, and said operation execution

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means executes the operation that is in accordance with said request signal if authentication that the network device is an authorized network device is obtained.” Dent et al fail to expressly disclose forgoing authentication processing if a request is not one requiring authentication.

In a similar field of endeavor, Jiang et al disclose skipping authentication if it is not necessary for a particular application (see paragraph 208).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Dent et al with Jiang et al to include the above skipping authentication when not necessary for an application in order to conserve system resources.

Claims 9, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dent et al in view of Lipovski (US 20040087318A1).

Regarding **claim 9**, Dent et al fail to disclose the request signal requesting operation execution is a signal requesting that emission of radio waves be inhibited.

In a similar field of endeavor, Lipovski discloses a transmitter sending a signal requesting a terminal to mute radio frequency generation (see paragraph 20).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Dent et al with Lipovski to include the above signal muting radio frequency generation in order to automatically restrict devices where they would create a distraction or in airplanes (see paragraphs 3-4).

Regarding **claim 10**, Dent et al fail to disclose the request signal requesting operation execution is a signal requesting that inhibition of emission of radio waves be cancelled.

In a similar field of endeavor, Lipovski discloses a transmitter sending a signal requesting a terminal to mute radio frequency generation, then at the exit, another to allow transmission (see paragraph 20).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Dent et al with Lipovski to include the above signal muting radio frequency generation and allowance in order to automatically restrict devices where they would create a distraction or in airplanes (see paragraphs 3-4) and to provide minimum inconvenience to the user.

Regarding **claim 11**, Dent et al fail to disclose the request signal requesting operation execution is a signal requesting that the mobile station make a transmission to power cut-off or to a standby operation.

In a similar field of endeavor, Lipovski discloses a transmitter sending a signal requesting a terminal to mute radio frequency generation (see paragraph 20), which reads on the claimed, "standby operation."

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Dent et al with Lipovski to include the above signal muting radio frequency generation in order to automatically restrict devices where they would create a distraction or in airplanes (see paragraphs 3-4).

Claims 12, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dent et al in view of Durst et al (US 20030122707A1).

Regarding **claim 12**, Dent et al fail to disclose that the request signal requesting operation execution is a signal requesting disclosure of mobile terminal information possessed by the mobile terminal.

In a similar field of endeavor, Durst et al disclose a base station transmits a location information request to a mobile terminal and the terminal responds with current location information (see paragraph 39), which reads on the claimed, "said request signal requesting operation execution is a signal requesting disclosure of mobile terminal information possessed by the mobile terminal."

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Dent et al with Durst et al to include the above location information update in order to assist the authorities in case of an emergency by providing the location of a user.

Regarding **claim 14**, Dent et al fail to disclose the mobile terminal information is status information of the mobile terminal.

In a similar field of endeavor, Durst et al disclose a base station transmits a location information request to a mobile terminal and the terminal responds with current location information (see paragraph 39), which reads on the claimed, "said mobile terminal information is status information of the mobile terminal."

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Dent et al with Durst et al to include the above location

information update in order to assist the authorities in case of an emergency by providing the location of a user.

Regarding **claim 15**, Dent et al fail to disclose the status information is voltage information indicating residual capacity of a battery of the terminal, or traveling-velocity information measured by a mobile unit, or present-position information detected by a mobile unit.

In a similar field of endeavor, Durst et al disclose a base station transmits a location information request to a mobile terminal and the terminal responds with current location information (see paragraph 39), which reads on the claimed, "said status information is voltage information indicating residual capacity of a battery of the terminal, or traveling-velocity information measured by a mobile unit, or present-position information detected by a mobile unit."

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Dent et al with Durst et al to include the above location information update in order to assist the authorities in case of an emergency by providing the location of a user.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dent et al in view of Durst et al, as applied to claim 12 above, and further in view of what was well known in the art (see MPEP 2144.03).

Regarding **claim 13**, the combination of Dent et al and Durst et al fails to expressly disclose that the mobile terminal information is user settings information that a

user of the mobile terminal has stored beforehand in a storage unit of the mobile terminal.

The examiner takes official notice that disclosing user settings information that a user of the mobile terminal has stored beforehand in a storage unit of the mobile terminal was well know to a person of ordinary skill in the art at the time of the invention.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Dent et al and Durst et al such that the mobile terminal information is user settings information that a user of the mobile terminal has stored beforehand in a storage unit of the mobile terminal in order to allow a network to provide services according to these settings.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan J Fox whose telephone number is (571) 272-7908. The examiner can normally be reached on Monday through Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Bryan Fox
May 25, 2005

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